Remarks/Arguments:

Claims 11 and 19, previously presented, are pending.

Claims 1-10, 12-18, and 20-22 are canceled, without prejudice or disclaimer.

Claims 11 and 19 were rejected under 35 USC 103(a) as allegedly being unpatentable based on *Nucleic Acids Research, 26*, 1854-1855, 1998 (Nakahara) in view of US5654142 (Kievits), *Nucleic Acids Research, 26* (1998), 2150-55 (Leone), and *Methods in Molecular Biology, 38* (1994), 253-60 (Malek). Reconsideration is requested.

Applicants incorporate herein by reference their remarks traversing the §103(a) rejection set forth in the response filed May 8, 2006.

Additionally, attention is directed to applicants' argument (Response filed May 8, 2006, page 8, 1st incomplete paragraph) (emphasis added):

> Nakahara and Kievits disclose optimal ITP concentrations for RNA amplification at 2.0 mM and 2.5 mM, respectively. As such, since "a person of ordinary skill, upon reading the reference[s], . . . would be led" to use an optimal maximum ITP concentration of 2.5 mM, which is "in a direction divergent from the path that was taken by the applicant," i.e., using a minimum ITP concentration of 3.2 mM, the references teach away from the presently claimed invention. *Gurley*, 31 USPQ2d 1131.

The statement of (final) rejection disputes this argument, alleging (final Office Action, page 6)

> Nakahara does not teach an optimal concentration of ITP at 2.0 mM . . . but rather teach[es] the use of ITP at a concentration of 0-4mM (see page 1855, legend to Figure 1), which falls within the range claimed by Applicant.

First of all, the statement of rejection is clearly erroneous as to the alleged facts. Nakahara (page 1854, right hand column) teaches, *verbatim*, "The optimal ITP concentration was determined

to be 2 mM" and, further, "in all the following experiments, NASBA was carried out in the presence of 2 mM ITP."

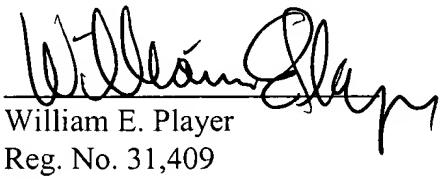
Secondly, irregardless of what else Nakahara teaches, it cannot change the fact that the reference would have taught one skilled in the art that "2 mM" is the "optimal ITP concentration." Accordingly (as applicants correctly argued) "a person of ordinary skill, upon reading the [Nakahara] reference . . . would be led in a direction divergent from the path that was taken by the applicant"—to use 2 mM of ITP (the optimal concentration taught in reference) instead of using the minimum ITP concentration of 3.2 mM, in accordance with applicants' invention as presently claimed—which renders the claimed invention patentable over the cited references. *In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

For the foregoing reasons, withdrawal of the rejection under §103(a) appears to be in order.

Favorable action is requested.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By 

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